

REMARKS

In the Office Action, the Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph; claims 1-4, 9-11, and 14-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,136,650 to Manookian, Jr. ("the '650 patent"); rejected claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,586,996 to Manookian, Jr. ("the '996 patent"); rejected claims 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,429,101 to Uebelhoer et al. ("the '101 patent"); and rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over the '650 patent in view of U.S. Patent No. 4,561,409 to Fernandez.

Applicants wish to thank the Examiner for taking the time to talk with Applicants' representative during the telephonic interview on April 4, 2005. The Examiner was very helpful in providing the reasoning not apparent in the Office Action for the rejections. The following remarks are consistent with the topics discussed during the interview.

Rejection under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claim 8 under 35 U.S.C. § 112, second paragraph. In view of the amendment to claim 8, the § 112, second paragraph rejection is moot and should be withdrawn.

Rejections under 35 U.S.C. § 102

Applicants respectfully traverse the rejection of claims 1-4, 9-11, and 14-20 under 35 U.S.C. § 102(b) as being anticipated by the '650 patent. The rejected claims are not anticipated by the '650 patent, because the '650 patent fails to disclose every element of independent claims 1, 14 and 20.

With respect to independent claim 1, the '650 patent fails to disclose at least a "conduit operably connected on a first end to the engine; condensing media in the

conduit adapted to condense oil from the blowby gases; and a collection unit in fluid communication with the conduit and adapted to receive the blowby gases from the conduit.”

The '650 patent discloses a vapor recovery system including a filter 24 and filter element 28 to separate condensed oil vapors from the flow of blowby gases from the crankcase 12 to the engine intake 30. The '650 patent fails to disclose “condensing media in the conduit.” Rather the '650 patent discloses condensing media 28 in a filter housing 24, and not a conduit.

As best understood from the Office Action, it appears that at least line 22 and filter 24 are interpreted as both the claimed transfer passage and the collection unit. However, the Office Action also indicates that filter 24 is the collection unit. Because the claims require “a collection unit in fluid communication with the conduit and adapted to receive the blowby gases from the conduit,” the same element, filter 24, cannot be both the transfer passage, including the conduit, and the collection unit because one thing cannot be in communication with itself, nor can it receive something from itself. These must be distinct elements. For at least these reasons, the '650 patent fails to disclose each element of independent claim 1.

With regard to independent claim 14, the '650 patent fails to disclose at least “a conduit operably connected on a first end to the engine; passing the blowby gases through condensing media in the conduit to condense oil from the blowby gases; collecting the condensed oil and the blowby gases from the transfer passage in a collection unit.”

Although unclear, the Office Action seems to apply similar reasoning to claim 14 as with claim 1. As such, the '650 patent also fails to disclose each element of claim 14 because the '650 patent discloses condensing media 26 in a filter 24, and not in a conduit. Additionally, the filter 24 cannot be both the transfer passage, including the conduit, and the collection unit because the collection unit collects the condensed oil and the blowby gases *from* the transfer passage. Something cannot collect from itself. For at least these reasons, the '650 patent fails to disclose each element of independent claim 14.

With regard to independent claim 20, the '650 patent fails to disclose at least a "conduit operably connected on a first end to the engine; means in the conduit for condensing oil from the gases; and a collection unit in fluid communication with the conduit and adapted to receive the gases from the conduit."

The Office Action also seems to apply similar reasoning to claim 20 as with claims 1 and 14. As such, the '650 patent also fails to disclose each element of claim 20 because the '650 patent discloses condensing media 26 in a filter 24, and not condensing means in a conduit. Additionally, the filter 24 cannot be both the claimed transfer passage, including the conduit, and the collection unit because the collection unit cannot be in communication and receive something from itself. For at least these reasons, the '650 patent fails to disclose each element of independent claim 20.

For at least the reasons discussed above, Applicants respectfully submit that independent claims 1, 14 and 20 are allowable over the '650 patent. Claims 2-4, 9-11 and 15-19 each depend from one of independent claims 1 and 14, and as such are allowable at least for their dependency on allowable claims.

Applicants respectfully traverse the rejection of claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by the '996 patent. The rejected claims are not anticipated by the '996 patent, because the '996 patent fails to disclose every element of independent claim 1. While the rejection is outlined in the Office Action as a rejection of claims 12 and 13, each of these claims depends, and necessarily includes all of the limitations of, independent claim 1.

The '996 patent discloses a vapor recovery system including a filter housing 46 and filter element 56 to separate condensed oil vapors from the flow of blowby gases from the crankcase 20 to the engine intake 12. The '996 patent fails to disclose "condensing media in the conduit." Rather the '996 patent discloses condensing media 56 in a filter housing 46, and not in a conduit.

As best understood from the Office Action, it appears that at least line 36 and filter assembly 38, including filter housing 46, are interpreted as both the claimed transfer passage and the collection unit. However, the Office Action also indicates that filter housing 46 is the collection unit. Because the claims require "a collection unit in fluid communication with the conduit and adapted to receive the blowby gases from the conduit," the same element, filter housing 46, cannot be both the transfer passage, including the conduit, and the collection unit because one thing cannot be in communication with itself, nor can it receive something from itself. These must be distinct elements. For at least these reasons, claims 1, 12 and 13 are allowable over the '996 patent because it fails to disclose each element of independent claim 1, and by dependency, claims 12 and 13.

Applicants respectfully traverse the rejection of claims 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by the '101 patent. The rejected claims are not anticipated by the '101 patent, because the '101 patent fails to disclose every element of independent claim 21.

The '101 patent discloses a filter element 14 for filtering oil from blowby gases in an engine 3. The '101 patent fails to disclose at least the “condensing media in the conduit,” as included in claim 21. Rather the '101 patent discloses condensing media 14 in a filter housing 30, and not in a conduit. For at least this reason, and reasons similar to those applied to the rejections above, claims 21 and 22 are allowable over the '101 patent.

Rejections under 35 U.S.C. § 103

Applicants respectfully traverse the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over the '650 patent in view of the '409 patent. No *prima facie* case of obviousness has been established with respect to claims 5 and 6 for at least the reason that neither the '650 patent nor the '409 patent, either alone or in combination, discloses or suggests every claim element.

As discussed above, the '650 patent fails to disclose at least “condensing media in the conduit” as claimed in independent claim 1. The '650 patent also does not suggest “condensing media in the conduit.” The '409 patent, cited only for its recitation of a helical coil, fails to remedy this deficiency. For at least this reason, the § 103 rejection of claims 5 and 6 should be withdrawn.

Applicants respectfully traverse the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over the '650 patent in view of the '432 patent. No

prima facie case of obviousness has been established with respect to claims 7 and 8 for at least the reason that neither the '650 patent nor the '432 patent, either alone or in combination, discloses or suggests every claim element.

As discussed above, the '650 patent fails to disclose or suggest a "collection unit in fluid communication with the conduit and adapted to receive the blowby gases from the conduit." The '432 patent, cited only for its recitation of wire mesh, fails to remedy this deficiency. For at least this reason, the § 103 rejection of claims 7 and 8 should be withdrawn.

New Claim 23

By this amendment, new claim 23 is added. Applicants submit that claim 23 is allowable over the prior art. None of the cited prior art references disclosed or suggests at least "a collection unit in fluid communication with the blowby gas transfer passage and adapted to receive the blowby gases and the condensed oil from the blowby gas transfer passage."

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 22, 2005

By: 
F. Chad Copier
Reg. No. 54,047